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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,779	09/15/2000	David R. Corbin	35-21(51376)B	2711

7590 04/02/2002
Timothy K Ball Phd
Patent Department E2NA
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EXAMINER

GALITSKY, NIKOLAI M

ART UNIT PAPER NUMBER

1631

DATE MAILED: 04/02/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/663,779

Applicant(s)

CORBIN ET AL.

Examiner

Nikolai M Galitsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-50 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Applicants' respond to restriction requirement filed 02.26.2002(Paper #8) is acknowledged. Applicant elected Group III invention directed to claims 36-37 without traverse. However, upon further review of the restriction it deemed necessary to redo the restriction. A telephone call was made to Attorney Timothy K. Ball on March 22, 2002 to request an oral election to the below new restriction requirement, but did not result in an election being made. A detailed restriction letter is therefore drafted as following.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-16, 25-32, and 49, drawn to a nucleic acid and cells, classified in class 536, subclass 23.1 and class 435, subclasses 243 and 325. If this Group is elected, then the below summarized sequence election is also required.
- II. Claims 17-24 and 50, drawn to a protein, classified in class 530, subclass 350. If this Group is elected, then the below summarized sequence election is also required.
- III. Claims 36-37, drawn to computer readable medium, classified in class 360, subclass 131. If this Group is elected, then the below summarized sequence election is also required.
- IV. Claim 40, drawn to a method for identifying a gene for an insect inhibitory protein, classified in class 435, subclass 6.
- V. Claims 41-48, drawn to a method for identifying plasmid DNA of a *Bacillus* species, classified in class 435, subclass 6.

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VI. Claims 33-35, 38 and 39, drawn to a transformed plant and a method of generating a transgenic plant, classified in class 435, subclass 410. If this Group is elected, then the below summarized sequence election is also required.

The inventions are distinct, each from the other because:

Inventions I and IV-VI are unrelated to invention II. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions have different modes of operation and different functions. The first set of inventions is distinct from invention II because the former require isolated DNA not required by the latter, while the latter requires isolated proteins not required by the former. Furthermore, the protein of invention II could be made by a process other than the expression of the gene of invention VI, such as chemical synthesis or purification from the natural source, and the DNA of invention I may be used for processes other than the production of protein, such as a nucleic acid hybridization assay. Lastly, DNA and protein differ in composition, structure and function.

Inventions I-IV and VI are unrelated to each other. Invention VI requires methods for plant transformation and regeneration, not required by the other inventions. Invention IV requires methods for identifying insect inhibitory proteins, not required by the other inventions. Invention V requires DNA libraries from two different *Bacillus* strains, not required by the other inventions.

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Inventions I-II and IV-VI are unrelated to invention III. Inventions I-II and IV-VI require nucleic acids or proteins, not required by invention III, which requires a computer readable medium and methods for recording information on it, not required by the other inventions.

SEQUENCE ELECTION FOR GROUP I, II, III, OR IV.

Applicant is reminded that nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq (see MPEP 803.04 and 2434).

Upon election of either Group I, or II, or III, or VI, Applicant is additionally required to select a single nucleotide sequence for said Group. This requirement is not to be construed as a requirement for an election of species, since each nucleotide and amino acid sequence is not a member of single genus of invention, but constitutes an independent and patentably distinct invention. Upon election of a single nucleotide sequence, claims that are not drawn to the function of the protein encoded by that nucleotide sequence would be withdrawn from consideration.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, fields of search, and classification, restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

It is acknowledged that a Petition to Suspend Sequence Rules has been filed (certificate of mailing: 09/15/00). After this Office action is mailed this Petition will be forwarded to the appropriate authority for consideration. Applicants are reminded that a CD-ROM may now be submitted instead of a paper copy of the sequence listing for the specification. Such a CD-ROM would be in addition to the separate computer readable form sequence listing already supplied.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

EXAMINER INFORMATION

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 C.F.R. § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolai M Galitsky, PhD whose telephone number is (703) 308-2422. The examiner can normally be reached on M-F (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward, Ph.D., can be reached on (703) 308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Patent Analyst, William Phillips, whose telephone number is (703) 305-3482 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

Date: 03.28.2002

Examiner Initials: *MG*

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER